THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 7

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte MARIS J. ZIEMELIS and WILLIAM R. R. PARK

Appeal No. 95-3398
Application No. 08/103,318[1]

ON BRIEF

Before CAROFF, Administrative Patent Judge, McKELVEY, Senior Administrative Patent Judge and OWENS, Administrative Patent Judge.

CAROFF, Administrative Patent Judge.

DECISION ON APPEAL

This decision on appeal relates to the final rejection of claims 27-34, all the claims remaining in the involved application.

[1] Application for patent filed August 9, 1993. According to the appellants, the application is a continuation of Application No. 07/926,619, filed August 10, 1992, which is a division of Application No. 07/563,123, filed August 6, 1990, now Patent No. 5,026,781, which is a division of Application No. 07/460,771, filed January 4, 1990, now Patent No. 5,135,989, which is a division of Application No. 07/334,501, filed April 7, 1989, now Patent No. 4,898,913.

The claims relate to a hydrophilic copolymer having a cross-linked hydrophobic copolymer backbone with an acrylic acid or methacrylic acid monomer polymerized on its surface, so that carboxylic acid sites are formed on the surface of the hydrophobic backbone copolymer.

Claims 31 is illustrative and reads as follows:

31. A hydrophilic copolymer comprising a cross-linked hydrophobic polymer, produced by precipitation polymerization in a solvent of at least one polyunsaturated ester monomer soluble therein, the polymer containing a monomer polymerized on the surface of the hydrophobic polymer, in order to form carboxylic acid sites on the surface of the hydrophobic polymer, the polymer being in a form including unit particles of less than about one micron in average diameter, fused unit particles of sizes in the range of about twenty to eighty microns in average diameter, and aggregates of clusters of fused unit particles of sizes in the range of about two hundred to about twelve hundred microns in average diameter, the monomer polymerized on the surface being selected from the group consisting of acrylic acid and methacrylic acid.

The examiner relies upon the following references of record as the evidentiary basis for rejecting appellants' claims:

Albright	3,767,600	Oct. 23, 1973
Frechtling	3,892,822	July 01, 1975
Carmody et al. (Carmody)	4,948,818	Aug. 14, 1990

The following rejections are before us for consideration:

I. Claims 27-34 stand rejected under the judicially created doctrine of obviousness-type double patenting over claims 1-14 of Carmody.

II. Claims 27-34 also stand rejected for obviousness under 35 U.S.C. § 103 in view of Albright taken in combination with Frechtling.

Based on the record before us, we agree with appellants that the examiner has failed to establish a prima facie case of obviousness with regard to each of the rejections before us. Accordingly, we shall not sustain either of those rejections which we now address seriatim:

I. The "Double Patenting" Rejection

The examiner acknowledges that the claims of Carmody do not expressly require that either acrylic acid or methacrylic acid be polymerized onto the surface of a hydrophobic copolymer. To remedy this deficiency, the examiner refers to Example III in the Carmody specification as showing the polymerization of methacrylic acid onto the surface of a hydrophobic copolymeric powder. This approach is improper since, when considering the question of obviousness-type double patenting, the patent disclosure may not be used as prior art. See In re Vogel, 422 F.2d 438, 441, 164 USPQ 619, 622 (CCPA 1970).

In directing attention to Carmody Example III, the examiner incorrectly states that methacrylic acid is the hydrophilic monomer of the Carmody claims. Rather, as we see it, the

hydrophilic monomer mentioned in the Carmody claims is one of the initial monomers used in forming a macroporous cross-linked copolymer powder and, therefore, is not used as in Example III to treat the surface of an already formed cross-linked hydrophobic copolymeric lattice (Carmody: column 9, line 54-column 10, line 6). Further in this regard, we note that neither acrylic acid nor methacrylic acid are ever mentioned by Carmody as a monomer which may be used to construct the initial cross-linked copolymeric structure as recited in the Carmody claims.

II. The 35 U.S.C. § 103 Rejection

We are unpersuaded by the examiner's assertions regarding the combinability of Albright and Frechtling under 35 U.S.C. § 103. Unlike the examiner, we find that the prior art provides no clear motivation to combine the teachings of these references and thereby arrive at appellants' invention. First of all, as noted by appellants, Albright and Frechtling each relate to different types of polymers - Albright relates to porous, macroreticulated polymers cross-linked with a polyunsaturated monomer, whereas the vinyl acetate monomer and dialkyl fumarate monomer of Frechtling are both monounsaturated. No poly-unsaturated monomers are used by Frechtling. In this sense, the references applied by the examiner are non-analogous.

Furthermore, the examiner asserts that those of ordinary skill in the art would discern a need to make the Albright polymers more hydrophilic, and therefore more wettable, when used as ion exchange resins. This assertion appears to be based on unsupported speculation on the part of the examiner inasmuch as Albright is apparently unconcerned with the enhancement of hydrophilic properties. In fact, the polymers of Albright are designed to be used in both aqueous and nonaqueous media (Albright: column 2, lines 18-20). Indeed, the examiner has not even established a nexus in the prior art between the hydrophilic characteristics of a resin and its ion exchange properties.

Additionally, the combination of Frechtling with Albright is even more problematic in that each relates to resins having different ultimate utilities. The polymers of Albright are used as adsorbents or ion exchange resins. On the other hand, Frechtling is concerned with forming a free-flowing powder which can be converted to a stable latex by the addition of water. In this regard, the following portions of the Frechtling disclosure are particularly pertinent: column 1, lines 9-27; column 3, lines 45-51; column 4, lines 21-27; column 5, lines 51-55; column 6, lines 8-21. Accordingly, we fail to discern any logical reason

why an ordinary artisan would have been motivated to apply the teachings of Frechtling to Albright's polymeric products.

In conclusion, we agree with appellants that the combination of references applied by the examiner against the claims is unsound. The examiner in effect has used the instant claims as a blueprint for combining the references which amounts to impermissible hindsight. Accordingly, we shall not sustain the 35 U.S.C. § 103 rejection.

For all of the foregoing reasons, the decision of the examiner is reversed.

REVERSED

MARC L. CAROFF Administrative Patent Judge	)
FRED E. McKELVEY Senior Administrative Patent Judge	) BOARD OF PATENT APPEALS AND INTERFERENCES
TERRY J. OWENS Administrative Patent Judge	)

Appeal No. 95-3398
Application No. 08/103,318

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Appeal No. 95-3398
Serial No. 08/103,318

Judge CAROFF

Judge OWENS

Senior APJ McKELVEY

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DECISION: REVERSED

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Index Sheet-2901 Rejection(s): _____

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